

REMARKS

A Declaration of Graham McFarland (hereinafter, "the McFarland Declaration"), a Declaration of the Inventors Under Rule 131 (hereinafter "the Inventor's Declaration"), and a Declaration of Carl A. Forest Under Rule 131 (hereinafter "the Forest Declaration") are enclosed. These Declarations were not provided earlier because it could not be anticipated that the Office Action would maintain positions believed not to be supported by the references, as specified in more detail below.

Please note for future charges that Applicants no longer claim small entity status. A Notification Of Loss Of Entitlement To Small Entity Status is enclosed.

Claims 1 – 86 are pending in this application. Claim 20 was objected to because of an informality. Claim 20 has been amended to overcome this objection.

Reply to The Examiner's Response To Argument

The Office Action cites *In re Keller* and *In re Merck & Company* against the proposition that none of the references cited by the Examiner has a processing unit that does all of the claimed functions. The Examiner is correct here, but the statement on lines 9 to 11 on page 18 of the prior argument is not only an incorrect statement of the law, but it is not a correct summary of the argument that follows. The undersigned apologizes for this error. The actual argument was that there are some limitations in claims 1 and 44 that are not found in any reference. The courts do state that a rejection is improper if there is some limitation that is not in any of the references. See, for example, *In re Glass*. Notably, as argued in the previous response, neither Kurokawa et al. nor Garfinkle et al. show a processing unit that transmits routing information to a photographer processing unit. The Examiner states that Kurokawa et al. shows this on page 2, paragraphs 27 and 32. However, what Kurokawa et al. discloses is a closed system in which the photographer can only communicate with the service shop (fulfillment center) that takes the order. If this service shop is closed or is undesirable for some reason, the order receiving page of the new service shop is substituted. That is, in any case, the order is taken by the fulfillment center processor of the fulfillment center that actually prints the order. This is different from what is recited in claims 1 and 44 where the computer that takes the order (the first processor) sends to the photographer computer the routing information of where to send the digital image.

Similarly, Applicants believe that each of the other points raised in the response to the last Office Action are correct. However, in fact, Kurokawa et al. is not prior art under the patent law. Therefore, Applicants submit herewith Rule 131 Declarations.

Claim Rejections – 35 USC §103

Claims 1 – 6, 15 – 32, 34 – 40, 43 – 49, 58 – 75, 77 – 83, and 86 have been rejected under 35 USC 103(a) as being unpatentable over Kurokawa et al. (US Patent Application Publication No. 2001/0049640) and Garfinkle et al. (US Patent No. 6,017,157). This rejection is respectfully traversed.

It is strongly believed that the Office Action does not contain a prima facie obviousness argument. However, it is evident that the Examiner has a different point of view. This is an important patent application on which a thriving business is based. Therefore, to move this application forward, the Inventors' Declaration is enclosed showing completion of the invention in this country before the June 1, 2001 filing date of Kurokawa et al. by showing reduction to practice of the invention by at least mid-May 2001. The effective date of the Kurokawa et al. patent is less than one year prior to the date on which the present application was filed, i.e., September 20, 2001; therefore, under the patent law, Kurokawa et al. is not prior art.

It is noted that even if reduction to practice were not shown, conception of the invention prior to the effective date with due diligence from prior to said date to the filing of the patent application is shown, since the Applicants had authorized the filing of a patent application at least by April 12, 2001, which is before the filing date of Kurokawa et al., and reasonable delay by a patent attorney does not contravene diligence. See *Gould v Scharlow*, 363 F.2d 908, 916, 150 USPQ 634 (CCPA 1966) and *Rins v Morgan*, 250 F.2d 365, 369, 116 USPQ 145, 148 (CCPA 1957), for example. The Forest Declaration shows that the delay by the attorney was reasonable, since the firm had recently been acquired by Patton Boggs LLP and had lost all but two of its associates capable of writing the application, and had a huge backlog of patent applications. However, diligence really is not required since the Inventors' Declaration shows actual reduction to practice prior to the effective date of Kurokawa et al. Further, if that is not enough, the due diligence is also shown by the Source Control History of Exhibits F, G, H, and I attached to the Inventors' Declaration (See the Inventors' Declaration, ¶¶ 2 – 17).

Since Kurokawa et al. is not prior art, the rejection of claims 1 - 6, 15 - 32, 34 - 40, 43 - 49, 58 - 75, 77 - 83, and 86 under 35 USC 103(a) is overcome.

Claims 7, 33, 41, 42, 50, 76, 84, and 85 have been rejected under 35 USC 103(a) as being unpatentable over Kurokawa et al. (US Patent Application Publication No. 2001/0049640) and Garfinkle et al. (US Patent No. 6,017,157) as applied to claims 1 and 44 above, and further in view of Jackson et al. (US Patent No. 6,760,128). This rejection is respectfully traversed. Since Kurokawa et al. is not prior art, the rejection of claims 7, 33, 41, 42, 50, 76, 84, and 85 under 35 USC 103(a) is overcome.

Claims 8 - 11 and 51 - 54 have been rejected under 35 USC 103(a) as being unpatentable over Kurokawa et al. (US Patent Application Publication No. 2001/0049640), Garfinkle et al. (US Patent No. 6,017,157), and Jackson et al. (US Patent No. 6,760,128) as applied to claims 7 and 50 above, and further in view of Norris (US Patent No. 6,105,007). This rejection is respectfully traversed. Since Kurokawa et al. is not prior art, the rejection of claims 8 - 11 and 51 - 54 under 35 USC 103(a) is overcome.

Claims 12 - 14 and 55 - 57 have been rejected under 35 USC 103(a) as being unpatentable over Kurokawa et al. (US Patent Application Publication No. 2001/0049640) and Garfinkle et al. (US Patent No. 6,017,157) as applied to claims 1 and 44 above, and further in view of Marwell et al. (US Patent No. 6,404,884). This rejection is respectfully traversed. Since Kurokawa et al. is not prior art, the rejection of claims 12 - 14 and 55 - 57 under 35 USC 103(a) is overcome.

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance. Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-1848, under Order No. 010684.0103PTUS from which the undersigned is authorized to draw.

Respectfully submitted,
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